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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,750	05/21/2001	John Skalen	P/1629-43	6152
2352	7590	08/02/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/787,750	<b>Applicant(s)</b> SKALEN, JOHN <i>al</i>	
	<b>Examiner</b> Mike Chambers	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The finality of the office action is withdrawn based on the BPAI decision of 5/11/04.

#### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 3/15/04 is insufficient to overcome the rejection of claims 6-11 based upon Deane in view of Windall as set forth in the last Office action because: The applicant has detailed his experience with a device with limitations that are not found in the existing claim language limitations.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection offered by the BPAI is reprinted below:

Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

The second paragraph of 35 U.S.C. 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson 55R F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

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Claim 6, the sole independent claim pending in this application, reads as follows:

6. A golf swing training device, comprising:

a golf ball;

a rigid line wherein a first end of said rigid line is secured to said golf ball and a second end of said rigid line is anchored to the ground at a predetermined distance in front of said golf ball;

a resilient line that is transverse to said rigid line and approximately bisected by said rigid line, said resilient line has both a first end and a second end anchored to the ground;

a ring that encloses said rigid line and said resilient line, wherein said ring is slidable along said rigid line and said ring is slidable along said resilient line; and

a plurality of marks located on said rigid line wherein a mark indicates a reference point for said resilient line to transverse said rigid line and said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark.

The relationship, if any, between the "plurality of marks" recited in the last paragraph of claim 6 and the positions of the rigid and resilient lines anchored to the ground as recited in the second and third paragraphs is not clear. We note that the rigid line and resilient line are positively recited as being anchored (not adapted to be anchored, for example) to the ground, the rigid line at one end and the resilient line at both ends, with the resilient line being transverse to the rigid line and approximately bisected by the rigid line. Claim 6, in the last paragraph, recites a plurality of marks, wherein a mark indicates a reference point for the resilient line to transverse the rigid line and wherein said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark. Inasmuch as claim 6 does not positively recite that the crossing of the resilient line and the rigid line at said mark referred to in the last paragraph corresponds to the position of anchoring of the lines recited in the second and third paragraphs of the body of the claim, it is not clear whether claim 6 is directed to (1) a golf swing training device with the rigid and resilient lines anchored such that the resilient line crosses the rigid line at a mark (i.e., a golf swing training device arranged in a particular manner for use with a predetermined type of club) or to (2) a golf swing training device comprising the rigid and resilient lines anchored with the resilient line crossing the rigid line at any point, either at a mark or not at a mark, and being approximately bisected by the rigid line, with the rigid and resilient lines being capable of being re-positioned and re-anchored such that the resilient line crosses the rigid line at a mark (i.e., a golf swing training device adapted for arrangement for use with a type of club of the user's choosing).

In an attempt to resolve the above-mentioned ambiguity, we have consulted appellant's specification. For the reasons which follow, appellant's specification not only fails to clarify this point but, in fact, heightens the ambiguity.

The present specification informs us, on page 1, that the present invention relates to a golf training arrangement comprising a rigid line having a free end "adapted to be anchored in the ground at a predetermined distance in front of the ball" and an elastic line having free ends which are "adapted to be anchored in the ground." This disclosure might lead us to the conclusion that interpretation (2) above is the correct reading of claim 6.

The specification also discloses on page 2 that "identified sections along the front portion of the rigid line indicate the distance from the ball to the ring interconnecting the lines and to the crossing elastic line, thereby providing an indication about which type of club [is] to be used." This language is ambiguous as to whether interpretation (1) or (2) is correct, inasmuch as it implies a particular arrangement of the device, as called for in interpretation (1), but with the markings ("identified sections") simply indicating distance to the crossing rather than marking the actual point of crossing. In other words, the referenced disclosure on page 2 of the specification does not indicate that the lines must cross at a mark.

Finally, page 5 of appellant's specification states that the distance from the ball to the crossing line 7 is marked on the rigid line 3 with sections A-C which could have the colours blue A, white B and yellow C. With reference thereto the location of

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the golf ball relatively the metal ring 6 and the crossing line 7 can easily be determined in response to the type of club used at the training.

This disclosure implies that the intent of the invention is to provide a training device wherein the crossing point of the rigid and elastic or resilient lines is determined in response to the type of club used in training, thus pointing toward interpretation (2).

Moreover, this disclosure describes the marks or colored sections A-C as marking distance from the ball to the crossing line rather than the location of the crossing itself and thus, like that on page 2 of appellant's specification, referred to above, appears to be inconsistent with the recitation in claim 6 that "said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark, thereby rendering claim 6 indefinite.

In light of the ambiguity and inconsistency discussed above, the metes and bounds of claim 6 cannot adequately be determined, thereby rendering the claim indefinite. Claims 7-11 depend from claim 6 and are likewise indefinite.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,7,11 are rejected under 35 U. S.C. 103(a) as obvious over the British reference (Deane) in view of Windall. Deane discloses the elements of claim 1.

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However it does not clearly disclose the use of indicia placed on the tether. Windall discloses the use of indicia on the tether (15,17,18). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the indicia of Windall with the apparatus of Deane in order to reduce the manufacturing cost and reduce the number of sub-components of the apparatus. Note that the phrases in the claim directed to the intended manner of use of the device cannot be used to distinguish over prior art disclosing the structure.

As to claim 7: The dimensions cited are a matter of design choice. The specification provides no unexpected results in using a grip thickness is greater at one end of the shaft. It would have been obvious to one of ordinary skill in the art to have selected an appropriate length and size of the tether to insure the apparatus would operate in an appropriate manner.

As to claim 11: Deane discloses controlling the return of the ball (3: 1-7).

Claims 8-10 are rejected under 35 U. S.C. 103(a) as being unpatentable over the prior art cited in view of Official Notice. Official notice is given that attachment of balls and tethers are well known in the art. One of ordinary skill in the art would have selected an appropriate attachment means from one of many equivalent attachment means. The specification provides no unexpected results in using attachment means cited. It would



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have been obvious to one of ordinary skill in the art to have selected an appropriate attachment means to insure the apparatus would operate in a safe manner .

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on Mon-Fri 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 29, 2004



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